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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,443	04/20/2004	Richard Bacr	10030568-1	4008

7590 05/10/2007
AGILENT TECHNOLOGIES, INC.
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Intellectual Property Administration
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EXAMINER

KOZIOL, STEPHEN R

ART UNIT	PAPER NUMBER
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2609

MAIL DATE	DELIVERY MODE
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05/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/828,443

Applicant(s)

BAER, RICHARD

Examiner

Stephen R. Koziol

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claim 7 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 6. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims (1-18, 22-31, and 33) are rejected under 35 U.S.C. 102(b) as being anticipated by Janiak et al. US 2002/0030581 A1.

Regarding claim 1, Janiak discloses a biometric data card (fig 1 [16]), comprising: an image sensor for capturing an image of a biometric feature of a user of the biometric data card and producing first image data representing the image (fig 1 [16], also, par. [0027]); a memory operable to store second image data (fig 1 [16], also, par. [0027]); and a processor in communication with said image sensor and said memory, said processor operable to perform a comparison of the first image data with the second image data, and, to generate, in response to the comparison, authentication information representative of an authentication of the user (fig 1 [16], also, pars. [0027], [0039]).

Regarding claim 2, Janiak discloses an interface operable to transmit the authentication information from the biometric data card to a terminal (fig 1 [16], also, pars. [0027], [0039]).

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Regarding claim 3, Janiak discloses an interface operable to transmit the authentication information from the biometric data card to a terminal comprising a contact pad operable to form an electrical connection to the terminal, said contact pad being further operable to transmit the authentication information from the biometric data card to the terminal via the electrical connection (fig 1 [16], also, pars. [0027], [0039]).

Regarding claim 4, Janiak discloses a processor further operable to determine adjustment information for the terminal to use in capturing an additional image of the biometric feature and to transmit the adjustment information to the terminal via the interface (fig 1 [16], also, pars. [0027], [0039]).

Regarding claim 5, Janiak discloses an optical element for transferring the image to said image sensor (fig 1 [16], also, pars. [0027]).

Regarding claim 6, Janiak discloses a processor further operable to extract first feature characteristics from the first image data and second feature characteristics from the second image data, and to compare the first feature characteristics to the second feature characteristics to determine the authentication information (fig 1 [16], also, pars. [0027], [0039]).

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Regarding claim 7, Janiak discloses a biometric data card wherein: said second image data comprises second feature characteristics; and said processor is further operable to extract first feature characteristics from the first image data and to compare the first feature characteristics to the second feature characteristics to determine the authentication information (fig 1 [16], also, pars. [0027], [0039]).

Regarding claim 8 and 9, Janiak discloses a biometric data card wherein said image sensor is a CCD or CMOS image sensor (fig 9, also, par. 35).

Regarding claim 10, Janiak discloses a biometric data card wherein the biometric feature is at least one of an iris of an eye of the user, a facial feature of the user or a fingerprint of a finger (fig 1, also, pars. [0027], [0039]) of the user.

Regarding claim 11, Janiak discloses a terminal for authenticating a user of the terminal comprising: an optical interface configured to receive light reflected from a biometric feature of the user; an optical element optically coupled to said optical interface via an optical path, said optical element operable to form an image of the biometric feature from the reflected light and to direct the image onto an image sensor; and a card interface configured to receive a biometric data card and operable to authenticate the user based on the image and to provide an authentication signal to the terminal (fig. 1, fig. 10 [36], also, par. [0036] & [0039]).

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Regarding claim 12, Janiak discloses a card interface is operable to receive an authentication signal (fig 1, also, pars. [0027], [0036] & [0039]).

Regarding claim 13, Janiak discloses a card interface including a contact pad operable to form an electrical connection to the biometric data card, the authentication signal being received via the electrical connection (fig 1 & 10-15, also, pars. [0027], [0036] & [0039]).

Regarding claim 14, Janiak discloses a terminal, wherein the card interface is further operable to receive a feedback signal from the biometric data card, the feedback signal providing adjustment information to the terminal for use in capturing an additional image of the biometric feature (fig 1 & 10-15, also, pars. [0027], [0036] & [0039]).

Regarding claim 15, Janiak discloses a terminal wherein an image sensor is part of the terminal, and wherein the card interface is further operable to transmit image data representing the image produced by the image sensor to the biometric data card (fig 1 & 10-15, also, pars. [0027], [0036] & [0039]).

Regarding claim 16, Janiak discloses the optical pickup further directs the image onto the image sensor within the biometric data card. Angelo discloses such an optical interface that directs an image onto the image sensor within the biometric data card (fig 1 & 10-15, also, pars. [0027], [0036] & [0039]).

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Regarding claim 17 & 18, Janiak discloses a processor connected to receive the authentication signal and operable in response to the authentication signal to allow the terminal to interact with the user (fig. 1, fig. 10, also, par. [0036] & [0039]).

Regarding claim 22 Janiak discloses a terminal as part of an identification terminal (fig. 1, fig. 10 [36], also, par. [0036] & [0039]).

Regarding claim 23, Janiak discloses a terminal including a card interface configured to receive said biometric data card and operable to receive the authentication information from said biometric data card, said terminal further including an optical element arranged to direct light from the biometric feature onto the image sensor (fig 1 & 10-15, also, pars. [0027], [0036] & [0039]).

Claim 24 has been analyzed and is rejected for the reasons stated in claim 23 above.

Regarding claim 25, Janiak discloses, a card interface is further operable to receive from the biometric data card adjustment information for use by said terminal in capturing an additional image of the biometric feature (fig 1 [16], also, pars. [0027], [0039]).

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Regarding claim 26 Janiak discloses a method for authenticating a user using a biometric data card (fig 12), the method comprising: producing in the biometric data card first biometric image data in response to an image of a biometric feature of the user; comparing in said biometric data card the first biometric image data with second biometric image data; and authenticating the user in response to said comparing (fig 12, also, par. [0036] & [0039]).

Regarding claim 27, Janiak discloses a terminal able to interact with the user in response to an authentication signal (fig 1 & 12, also, pars. [0027], [0039]):

Regarding claim 28, Janiak discloses determining adjustment information for use by the terminal in capturing an additional image of the biometric feature; and transmitting the adjustment information from the biometric data card to the terminal (fig 1 [16], also, pars. [0027], [0039]).

Regarding claim 29, Janiak discloses an image capture and transfer method external to the biometric data card (fig 1 & 12, also, par. [0036] & [0039]).

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Regarding claim 30, Janiak discloses a method of extracting first feature characteristics from the image data to produce the first biometric image data; the second biometric image data includes second feature characteristics extracted from a previous image; and said comparing includes comparing the first feature characteristics to the second feature characteristics (fig 12, also, par. [0036] & [0039]).

Regarding claim 31, Janiak discloses a method of capturing an image on an image sensor in the biometric data card (fig 12, also, par. [0036] & [0039]).

Regarding claim 33, Janiak discloses communication with a remote server upon user authentication (fig 13 [222], also par. 0041).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows: (*See MPEP Ch. 2141*)

- a. Determining the scope and contents of the prior art;
- b. Ascertaining the differences between the prior art and the claims in issue;
- c. Resolving the level of ordinary skill in the pertinent art; and
- d. Evaluating evidence of secondary considerations for indicating obviousness or nonobviousness.

6. Claims (19-21, and 32) are rejected under 35 U.S.C. 103(a) as being unpatentable over Janiak as applied to applied to claim 11 above and further in view of Angelo US 6,182,892 B1.

Regarding claim 19, Janiak fails to further teach an illumination source to illuminate the biometric feature of the user. Angelo discloses an illumination source (fig 9 [97], laser diode) "used to transmit a light source into the waveguide substrate to illuminate the imprint of the finger" col. 6 ln. 38-39. Therefore, the combined teaching of Janiak and Angelo would have rendered obvious utilization of an illumination source in relation to the optical interface used to illuminate a biometric feature of the user.

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Regarding claim 20, Janiak fails to further teach the use of a lens in the optical element of the terminal. Angelo discloses the use of a gradient lens on a terminal (live-scan device) for capturing a biometric feature of the user (col. 5, ln. 50-54). Therefore, the combined teaching of Janiak and Angelo would have rendered obvious utilization of a lens in the optical element of the terminal.

Regarding claim 21, Janiak fails to further teach transfer optics located between the optical interface and optical element to direct the reflected light to said optical element. Angelo discloses the use of a "an offset optical path comprised of fiber optics from said platen to an image port on the outside of said module which allows an image of an illuminated imprint on said platen to pass to said image port; wherein said fiber optic bundle is coupled to, and transmits light through, a transmissive substrate and a waveguide hologram to illuminate and image said imprint" col. 14, ln. 5-12. Therefore, the combined teaching of Janiak and Angelo would have rendered obvious utilization of transfer optics between the optical interface and optical element of the terminal used to reflect light to the optical element.

Regarding claim 32, Janiak fails to further teach illuminating the biometric feature being scanned. Angelo discloses such an illumination source for the biometric feature being scanned (fig 1A, also, col. 6 ln. 36-41). Therefore, the combined teaching of Janiak and Angelo would have rendered obvious utilization of an illumination source for the biometric feature being scanned.

Examiner's Note

7. The referenced citations made in the rejection(s) above are intended to exemplify areas in the prior art document(s) in which the examiner believed are the most relevant to the claimed subject matter. However, it is incumbent upon the applicant to analyze the prior art document(s) in its/their entirety since other areas of the document(s) may be relied upon at a later time to substantiate examiner's rationale of record. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). However, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

Contact

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Koziol whose telephone number is (571) 270-1884. The examiner can normally be reached on M - alt. F 8:00-6:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vu Le can be reached on (571) 272-7332. Customer Service can be reached at (571) 272-2600. The fax number for the organization where this application or proceeding is assigned is (571) 273-7332.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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